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REMARKS

Claims 1-15 and 17-22 remain in this application. Claim 16 has been cancelled. Claims 1, 3, 9, 11, 15 and 17 have been amended. Claims 20-22 have been added. Claims 1, 11, 15, 21 and 22 are independent claims.

A. Allowable Subject Matter

Applicant notes with appreciation that in the Office action dated February 26, 2004, claims 8, 10 and 18 were deemed to be allowable over the prior art. The three claims were merely objected to as being dependent upon a rejected base claim. In response, Applicant has added independent claims 21 and 22. Claim 21 is a combination of the features of claim 8, its base claim 1, and the intervening claim 6. Similarly, new claim 23 is a combination of the features of claim 18, its base claim 15, and the intervening claim 17.

Based upon the indication of allowable subject matter, it is respectfully submitted that added claims 21 and 22 are in an allowable condition.

B. Objections to the Specification

Claim 16 was objected to because the limitation described in the claim was not disclosed in the specification. Claim 16 has been cancelled. Claim 19 was also objected to for lack of disclosure in the specification. Specifically, claim 19 was objected to because the memory feature was not specifically disclosed in the specification. In response, the paragraph that begins on line 21 of page 4 of the specification has been amended. Rather than stating that the historical information regarding prior selections by a user is "stored" and used, the paragraph now states that the historical information is stored in memory that is accessed and used by a video processor. In like manner, the paragraph that begins on line 8 of page 9 has been amended to state that the viewer selection information is stored in memory at step 72 for

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access by the video processor.

Applicant respectfully asserts that no new matter has been added by the amendments to pages 4 and 9. The memory feature and the accessing by the video processor were described in claim 19 as originally filed. Moreover, the amended paragraphs both stated that the information was "stored", which would be understood by a person of ordinary skill in the art as a retention in memory.

Reconsideration of claim 19 in view of the amendment to the specification is requested.

C. Claim Objections

Claims 1 and 15 were objected to because of a lack of antecedent basis for the term "said program categories." Applicant has amended the two claims to provide proper antecedent basis. The claims now state that each commercial broadcast is associated or identified with a program category of a plurality of program categories.

Claim 3 was objected to because of the lack of antecedent basis for the term "said step of determining associations." Claim 3 has been amended to more closely track the language of its base claim. The referenced step is one of determining said association for each commercial broadcast, rather than determining associations for the commercial broadcasts.

Reconsideration of claims 1, 3 and 15 is respectfully requested.

D. Rejections Based Upon the Prior Art

Claims 1, 2, 3, 9, 15 and 16 were rejected under 35 U.S.C. 102 (e) as being anticipated by Terasawa et al (hereinafter "Terasawa"). Claims 6 and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Terasawa in view of Agata et al (hereinafter "Agata"). Claims 4 and 5 were rejected under 35 U.S.C. 103(a) as being unpatentable over Terasawa in view

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of Noguchi et al (hereinafter "Noguchi"). Claim 17 was rejected under 35 U.S.C. 103(a) as being unpatentable over Terasawa in view of White. Claim 19 was rejected under 35 U.S.C. 103(a) as being unpatentable over Terasawa in view of Ohkura et al (hereinafter "Ohkura"). Claims 7 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Terasawa in view of Agata and further in view of Ohkura. Finally, claims 13 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Terasawa in view of Ohkura and further in view of Noguchi.

In response to the rejections, Applicant has amended independent claims 1, 11 and 15 and selected dependent claims to more clearly distinguish the claimed invention from the cited prior art. In all of the above-listed rejections, Terasawa was identified as the reference which teaches generating reduced-scale presentations for commercial broadcasts. The amended claims more clearly define the invention as being one in which the manipulations occur at a single site at which the reduced-scale presentations are displayed. For example, in claim 1, the method is now described as being one in which the reduced-scale presentations are locally originated from full-scale video information for exclusive display on the viewing screen. Similarly, claim 11 has been amended to describe the method as including receiving program transmissions at a particular site, identifying program categories for each television channel at the particular site, originating the reduced-scale presentations by signal manipulation that is original to the particular site, displaying each presentation on a single screen at the particular site, and enabling a viewer to select a particular presentation for full-scale viewing, wherein a selection for full-screen viewing is exclusive to the single screen at the particular site.

The amendments distinguish the invention from the teachings of Terasawa, which describe forming reduced-size still pictures at a central site using a transmission apparatus, so that the still pictures may be broadcast to households and other locations (in accompaniment with text information) for access on a promotion channel. Fig. 1 of Terasawa shows the transmitting apparatus for forming and broadcasting the reduced-sized still pictures.

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Figs. 20-24 of the patent show receiving equipment for accessing the promotion channel in order to view the reduced-sized still pictures that have been broadcast by the apparatus of Fig. 1. It follows that Applicant's claimed invention is distinguishable from the teachings of Terasawa since the viewing screen of claim 1 displays the reduced-scale presentations locally originated at the site of the viewing screen from full-scale video information for the commercial broadcast, while Terasawa describes the display of presentations on the single screen of Fig. 20 by accessing promotion channel information. That is, claim 1 describes the reduced-scale presentations as being originated from full-scale video information, while Terasawa merely displays received promotion information at the single screen of Fig. 20.

Original claim 9 described the step of generating the reduced-scale presentations as including displaying Incoming television programs in real time. Applicant respectfully asserts that a person of ordinary skill in the art would not interpret the description of displaying incoming television programs in real time as including the display of a "still picture of a typical frame" of a program being broadcast. Nevertheless, claim 9 has been amended to patentably distinguish the invention by describing the reduced-scale presentations as being miniaturized displays which are in constant synchronization with the television programs. Support for the amendment may be found on page 8, lines 28-35 of the application as originally filed. In this paragraph, it is stated that the reduced-scale presentations are continuously updated, so that the programs are simultaneously available for viewing, but at a miniaturized level. This embodiment is also described on page 6, lines 11-16, which state that the thirteen reduced-scale presentations may be displays of real time video information shown for each of the thirteen programs represented in Fig. 2. Added claim 20 also describes this embodiment.

Reconsideration of the claims in view of the amendments is requested.

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1. Exclusive Use Origination of Reduced-Scale
Presentations – Section 102

As previously noted, independent claims 1 and 15 were rejected as being anticipated by Terasawa under Section 102(e). The Office action asserted that Terasawa also teaches all of the features independent claim 11, with the exception of "overlapping presentations." Agata was cited for teaching this "overlapping" feature of claim 11.

To briefly state the standard, rejections under Section 102 are proper only when the claimed subject matter is identically disclosed or described in a single prior art reference, so that there are no physical differences. In re Marshall, 198 USPQ 344 (CCPA 1978). By amendment, claim 1 now states that the generation of the reduced-scale presentations includes locally originating the presentations from full-scale video information for exclusive display on the viewing screen. Also by amendment, independent claim 15 describes the video processor as being configured to receive the commercial broadcasts and being configured to output the reduced-scale presentations from the variety of commercial broadcasts, with the video processor and the viewing screen being operatively associated such that the presentations are available exclusively for the viewing screen. Applicant asserts that this distinguishes the invention from the teachings of Terasawa, so that the prior art patent no longer presents a prima facie case of anticipation with respect to independent claims 1 and 15. The "exclusive" feature is also added to independent claim 11.

The "exclusive" feature is not anticipated by the patent to Terasawa. The reduced-sized still pictures of Terasawa are originated at the central transmitting apparatus of Fig. 1, rather than the receiving equipment of Fig. 20. After the still pictures have been originated at the transmitting apparatus, they are broadcast to households. The transmitting apparatus of Fig. 1 includes an antenna (307) for transmitting the information to a satellite. Since the transmitting apparatus of Terasawa originates the still pictures for

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utilization at other locations, the operations of the transmitting apparatus do not anticipate the method and system described in amended claims 1, 11 and 15.

Viewed in an alternative manner, if the receiving equipment of Fig. 20 of Terasawa is considered to be the relevant site, the patent still does not anticipate the amended claims. Firstly, the still pictures of Terasawa are not "originated" at the receiving site. Moreover, the still pictures are not generated from full-scale video information (claim 1), since the still pictures of Terasawa are received in their reduced-sized format. Moreover, with regard to claim 15, the still pictures of Terasawa are not continuously updated video broadcast information.

Applicant asserts that the amendments to the claims overcome the Section 102 rejection.

2. Exclusive Use Origination of Reduced-Scale Presentations – Section 103

Turning to Section 103, it is conventional to generate and broadcast program guide information from a central source. This is described in column 1, lines 16-27 of Terasawa. The patent notes that for selecting a desired program from a variety of programs (e.g., 80 broadcast channels), an Electronic Program Guide (EPG) system may be provided in which the EPG is transmitted from a transmitting end and is received in a receiving end for display. The desired program can thus be selected positively by referring to the EPG. The program information that is centrally generated and then broadcast may merely be textual, but Terasawa teaches that reduced-sized still pictures of typical frames of the programs may also be generated and broadcast. Fig. 1 of Terasawa shows a transmitting apparatus for generating and broadcasting the still pictures and other EPG data. Following broadcasts, the program guide information may be received at a television site (Fig. 20 of the patent) for access via a promotion channel.

The present invention diverges from the conventional approach.

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Program guide information is generated at the location of the viewing screen and is generated for exclusive display on the viewing screen. Nothing within the teachings of Terasawa suggests transferring the responsibility of generating the program guide information to the individual viewing screens. Thus, in addition to being novel under Section 102, the amended claims are non-obvious under Section 103(a). This is true even when the overlapping feature of Agata is incorporated into the method and system of Terasawa. Agata does not relate to broadcasting. Instead, Agata is directed toward storage devices (such as computers) and displaying icons that represent content items (such as computer programs).

Noguchi was cited for its teachings regarding allowing a user to select one category that is then split into sub-categories. Noguchi is consistent with the teachings of Terasawa with regard to the source of the program information. For example, in the first sentence of the ABSTRACT and of the Noguchi patent, the invention is described as an innovative use of an on-line guide. Even if one were to modify Terasawa to incorporate this feature of Noguchi, Applicant's invention would not be obvious under Section 103, since the "exclusive" feature of the amended claims would not be taught or suggested. For example, in claim 1, the reduced-scale presentations are locally originated from full-scale video information for exclusive display on the viewing screen. The combination of Terasawa and Noguchi would still involve originating the still pictures at a remote central site for broadcast to various locations.

The White reference was cited for its teachings regarding updating. White describes a system and method for providing display images of recently viewed television channels. The invention is described primarily with respect to Internet use, such as WebTV. When a channel is de-selected, a representation of the channel is accessible at a "recent channel screen," such as shown in Fig. 8 of the reference. The recent channel screen includes a currently viewed display screen (86) that contains a live picture. The Office action states that White teaches that depending on the scan rate of the scanning system, the other channel display screens could be updated

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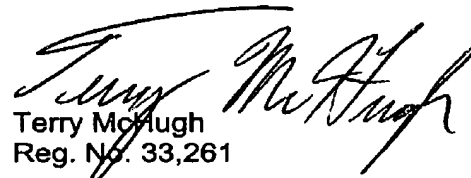
continuously, so that they each appear to display a live signal (citing Paragraph 0052). Applicant notes that this appearance of a live signal does not teach the claimed invention. Firstly, the channels are not continuously updated, since they are updated one at a time. Moreover, the White reference was cited with respect to claim 17, which has been further defined to state that the reduced-scale presentations are ongoing displays of the commercial broadcasts in real time. The combination of White and Terasawa does not render Applicant's claimed invention obvious under Section 103.

The Ohkura patent was cited with respect to claims relating to the use of historical information. Applicant respectfully submits that even if one were to modify Terasawa to incorporate selected teaching of Ohkura, the resulting method and system would not render the invention of independent claims 1, 11 and 15 obvious.

Applicant respectfully requests reconsideration of the claims in view of the amendments and remarks made herein. A notice of allowance is earnestly solicited. In the case that any issues regarding this application can be resolved expeditiously via a telephone conversation, Applicant invites the Examiner to call Terry McHugh at (650) 969-8458.

Respectfully submitted,

Date:



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